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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,009	09/13/2000	Thomas J. Colson	822.000308	8287

7590 09/10/2003

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,009

Applicant(s)

COLSON ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.6 6) ☐ Other: _____

Status of Claims

1. Claims 1-114 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16, 17, 27, 28, 35, 36, 41, 42, 46-50, 70, 71, 81, 82, 89, 90, 96, 97, and 102-107 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims recite "...transmitting to said client a notice of time remaining to file a patent application under applicable law on matter incorporated in said product..." However, the Applicant has not provided a system that understands or has knowledge of, a priori, the "matter incorporated in said product" in order to provide a client with the aforementioned notice.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 16, 17, 27, 28, 35, 36, 41, 42, 46-50, 70, 71, 81, 82, 89, 90, 96, 97, and 102-107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite "...transmitting to said client a notice of time remaining to file a patent application under applicable law on matter incorporated in said product..." However, the Applicant has not provided a system that understands or has knowledge of, a priori, the "matter incorporated in said product" in order to provide a client with the aforementioned notice.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 10-12, 15, 18, 21-23, 26, 29, 40, 43, 51, 56, 65-67, 69, 72, 75-78, 80, 83, 86, 95, 98, 101, 108, and 111 have been rejected under 35

U.S.C. 102(b) as being clearly anticipated by Beattie et al., U.S. Patent No. 5,659,742.

As per claims 1, 10-12, 15, 18, 21-23, 26, 29, 40, 43, 51, 56, 65-67, 69, 72, 75-78, 80, 83, 86, 95, 98, 101, 108, and 111, Beattie et al. teach a document access system comprising: a first website for accessing a public database that stores documents, a search engine (included in a website system) for accessing the documents, accessing the documents, receiving documents from a client and adding the documents to the database, where the documents comprise a primary document and one or more attachment files, and collecting and adding bibliographic data to the product document (figures 1-4c). Beattie et al. also teaches document notarization, obtaining document notarization, notarization including a timestamp and/or a digital fingerprint using a website, and recording the number of times a product document is accessed by an end-user (figure 5; column/line 35/57-36/52, column 37, lines 15-38).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-9, 13, 14, 16, 17, 19, 20, 24, 25, 27, 28, 30-39, 41, 42, 44-50, 52, 53-55, 57-64, 68, 70, 71, 73, 74, 79, 81, 82, 84, 85, 87-94, 96, 97, 99, 100, 102-107, 109, 110, and 112-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beattie et al., U.S. Patent No. 5,659,742.

As per claims 2-9, 13, 14, 16, 17, 19, 20, 24, 25, 27, 28, 30-39, 41, 42, 44-50, 52, 53-55, 57-64, 68, 70, 71, 73, 74, 79, 81, 82, 84, 85, 87-94, 96, 97, 99, 100, 102-107, 109, 110, and 112-114, Beattie et al. teach a document access system comprising: a first website for accessing a public database that stores documents, a search engine for accessing the documents, accessing the documents, receiving documents from a client and adding the documents to the database, where the documents comprise a primary document and one or more attachment files, and collecting and adding bibliographic data to the product document (figures 1-4c). Beattie et al. also teaches document notarization, obtaining document notarization, notarization including a timestamp and/or a digital fingerprint using a website, and recording the number of times a product document is accessed by an end-user (figure 5; column/line 35/57-36/52, column 37, lines 15-38). Beattie et al. do not specify the type of documents. However, as Beattie et al. broadly apply their system to allowing users to obtain textual and/or multimedia documents (video, audio or graphics information) it would have obvious for a publisher (figure 1) to represent a physical document in electronic form as text or multimedia or a combination of the two (figures 4a-c).

Regarding client fees, it would have been obvious for a service provider to charge a fee for providing a service in order to generate revenues. When the service provider chooses to levy such a fee is up to the discretion of the provider.

Regarding filing for patent applications, Beattie et al. provide users with a database for answering a wide range of questions, e.g. "What do you want to know?" (figure 4a); therefore, the system of Beattie et al. is necessarily set-up to provide a result in response to a query such as time remaining to file a patent application in order to avoid "on sale" or "public use" rejections.

As per claims 19, 20, 30, 31, Beattie et al. teach a publisher providing documents to database (figure 1). Beattie et al. do not specify a particular transfer protocol. However, it would have been obvious to one of ordinary skill to automate Making automatic (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 192, 196 (CCPA 1958)) the process by allowing clients to deliver their documents over the same channel that users access the database, using the internet (column 11, lines 28-67).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Iwai et al. teach a system for managing preparation and prosecution of patent applications
- Hobbs teaches a method and system for accessing multimedia information
- Ferguson et al. teach an online service development tool with fee setting controls such as fees for maintaining client content on its servers

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

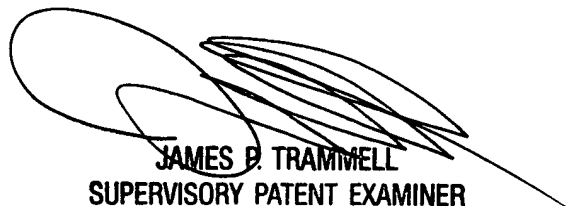
(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II

September 5, 2003



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
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